

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRIAN ANDREW CROTTY, CRAIG STEPHEN SLAVTCHEFF
and MICHAEL CHARLES CHENEY

Appeal No. 2003-0947
Application No. 09/854,372

ON BRIEF

Before SCHEINER, GRIMES and GREEN, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-6, all the claims pending in the application. Claim 1 is representative of the subject matter on appeal:

1. A cosmetic cream cleanser composition comprising:
 - (i) from about 0.1 to about 20% by weight of a silicate;
 - (ii) from about 0.001 to about 2% by weight of a crosslinked carboxyvinyl polymer other than a long chain C₁₀-C₃₀ alkyl acrylate or methacrylate containing polymer;
 - (iii) from about 0.01 to about 40% by weight of a silicone copolyol sulfosuccinate; and
 - (iv) a cosmetically acceptable carrier;

wherein the composition has a viscosity ranging from about 20,000 to about 500,000 cp.

The references relied on by the examiner are:

Guerrero et al. (Guerrero)
Mohammadi

5,236,710
6,264,964

Aug. 17, 1993
Jul. 24, 2001

Claims 1 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Guerrero and Mohammadi. We reverse the examiner's rejection of the claims.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including the claims on appeal; (2) appellants' Brief (paper No. 8); (3) the examiner's Answer (paper No. 9), and the non-final office action referred to in the Answer for the statement of the rejection (paper no. 2); and (4) the references relied on by the examiner.

DISCUSSION

Claim 1 is directed to a cosmetic cream cleanser, with a viscosity ranging from about 20,000 to about 500,000 cp., comprising about 0.1 to about 20% by weight of a silicate; about 0.001 to about 2% by weight of a crosslinked carboxyvinyl polymer other than a long chain C₁₀-C₃₀ alkyl acrylate or methacrylate containing polymer; about 0.01 to about 40% by weight of a silicone copolyol sulfosuccinate; and a cosmetically acceptable carrier. According to the specification, "[t]he term 'cream' requires both opacity and a certain thickness" (page 1); the crosslinked carboxyvinyl polymers of the invention include "acrylic acid/ethyl acrylate copolymers and [] carboxyvinyl polymers sold under the Carbopol® trademark" (page 4); and "[l]ong chain fatty group substituted polymeric ester[s] of acrylic or methacrylic acid such as Pemulen® with [the] CTFA name of acrylates/C10-30 alkyl acrylate crosspolymer are outside the scope of the invention" (id.).

Guerrero describes a cosmetic composition comprising about 0.1 to about 30% by weight of an emulsifying copolymer, "[a] critical component," "formed from a

carboxylic monomer . . . and a long chain acrylate ester;" about 0.01 to about 30% by weight of an anionic sulfosuccinate, for example, a silicone copolyol sulfosuccinate; and a cosmetically acceptable carrier (column 2, lines 15-32; column 3, lines 49-65; column 4, lines 26-31). The examiner concedes that Guerrero's emulsifying copolymer, an "acrylates/C10-C30 alkyl acrylate crosspolymer" "available . . . under the trademark Pemulen Tr-2²⁰⁰," is the type of crosslinked carboxyvinyl polymer that is specifically excluded from claim 1 (column 3, lines 41-45).

In addition, Guerrero's composition "may be in liquid, powder, stick or other form," but Guerrero explains that "it is especially desirable to utilize a gel state" and that "in fact, [the] compositions . . . are intended to be clear gels" (column 5, lines 6-9). Magnesium aluminum silicate is listed among a large number of optional vehicles and additives, but no amounts are specified (column 5, lines 1-2). Nevertheless, the examiner maintains that "one skilled in the art would have known how to make an opaque composition by optimizing the amount of powder such as the silicate" (paper no. 2, page 3).

Mohammadi describes a foaming cosmetic product "having a nice silky skinfeel" comprising a crosslinked carboxyvinyl polymer, a crosslinked non-emulsifying siloxane elastomer, and a volatile polyorganosiloxane. Column 1, lines 57-68 and column 7, line 15. Suitable crosslinked carboxyvinyl polymers "include Carbopol 934, Carbopol 940, Carbopol 980, Carbopol 1382, Carbopol 1342 and Pemulen TR-1" (column 3, lines 2-4).

According to the examiner, "[i]t would have been obvious to one of ordinary skill in the art . . . to have modified the composition of Guerrero [] by substituting the crosslinked carboxyvinyl polymers of Mohammadi for the copolymer of Guerrero []

because of the expectation of successfully producing a cosmetic cleansing composition with good stability, silky skin [feel], and rich foaming property” (paper no. 2, page 4), and because of “the equivalency of Pemulen and Carbopol polymers as described in Mohammadi” (Answer, page 4).

Clearly, the examiner has established that individual parts of the claimed invention were known in the prior art. However, as explained in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citations omitted):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. [] Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” []

Most if not all inventions arise from a combination of old elements. [] Thus, every element of a claimed invention may often be found in the prior art. [] However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. [] Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The examiner may establish a case of prima facie obviousness based on a combination of references “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” Id., 972 F.2d 1260, 1265, 23

USPQ2d 1780, 1783 (Fed. Cir. 1992).

The fact that the prior art could have been modified in a manner consistent with appellants' claims would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). While "[b]oth [Guerrero and Mohammadi] relate to the cosmetic art," appellants argue that "[t]he fundamental aspect of each reference lies with a product type different from the other," thus, one skilled in the art would not "look toward the pumped mousses of Mohammadi to [modify] . . . the gelled body rub of Guerrero," indeed "[one] skilled in the art seeking to develop a cream cleanser of the present invention would not particularly focus on Guerrero [] or Mohammadi for any source of inspiration" (Brief, page 7). Even though Guerrero "could be read to encompass opacity," the reference "focuses most attention on clear systems," and appellants argue that one skilled in the art "seeking to formulate opacity, would not find Guerrero [] to be the most likely template" (id., page 8). On this record, we agree with appellants that "[t]he switch of polymers from [Mohammadi] into [Guerrero] is not based upon any teaching or incentive within the references" (id.). In our view, the only reason or suggestion to combine the references in the manner claimed comes from appellants' specification.

Accordingly, the rejection of claims 1-6 under 35 U.S.C. § 103 is reversed.

REVERSED

Toni R. Scheiner
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

Lora M. Green
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
)
) APPEALS AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2003-0947
Application No. 09/854,372

Page 7

Unilever
Patent Department
45 River Road
Edgewater, NJ 07020